

Question Q217

National Group: Spanish

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. ***What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined ?***

Article 8.1 of the Spanish Patent Law 11/1986 of March 20th (from now on “**the Patent Law**”) states that “an invention is considered as involving inventive step if it is not obvious for a person skilled in the art having regard to the state of the art”. Thus, inventive step is evaluated from the perspective of the skilled artisan on the filing date of the patent application, or if apply, on the priority date. The state of the art for determining inventive step is delimited by application of articles 6.2, 7 and 8.2 of the Patent Law. In general terms, regulation of inventive step in the Patent Law follows the rules of the European Patent Convention (from now on “**EPC**”), signed in Munich on October 5th, 1973, and revised by the Act revising the EPC on November 21st, 2000.

2. *Has the standard changed in the last 20 years? Has the standard evolved with the technical / industrial evolution of your jurisdiction?*

The legal standard remained unchanged during the last twenty six years. In the practice it did not experienced a clear evolution, although it is true that in several technical backgrounds a tendency to reduce the requirement for inventive step has been reported. Still, it has to be reminded that several areas have experienced their greater technological evolution in the last twenty years, some of which have reached such ripeness that render much harder any new advanced, which in turn has an influence on the determination of the inventive step.

3 *Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines ?*

The Spanish Patent and Trademark Office publish Guidelines for examination of patent applications (from now on “**SPTO Guidelines**”). Chapters 6.5, 6.6, and 6.7 of said Guidelines deal specifically with the appreciation of inventive step.

As it may be expected, the Guidelines of the SPTO are substantially equivalent to the one published by the European Patent Office (from now on “EPO” and “Guideline of the EPO”), with only some slight differences.

The guidelines of the SPTO do not have any legal binding character, but have to be followed by the examiners of the SPTO. In that sense, its publication is a huge tool for inventors, companies and their advisers. Courts also frequently refer to that publication.

4 *Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings ?*

The legal standard is unique and applies indifferently for administrative matters as well as for jurisdictional matters. In the practice slight differences may appear mainly as a result of the two following factors :

- The SPTO Guidelines –devoid of legal binding character- link the examiners, but not the courts, without prejudice that said courts may take it into consideration, as it has been the case in many occasions.
- The examiners have a technical profile, without prejudice of their knowledge in legal aspects linked to the patentability criteria. On the contrary, the professional background of the judges is strictly legal, and the determination of inventive step they made mainly depends on the opinion of the technical experts. These experts are usually independents, but designated by the opposed parts, and as a consequence, they frequently give opposite opinions, with conclusions in favor of their constituting part and contrary to the opposite part. The courts have to evaluate the opinions of the experts “according to the rules of the logical and reasonable criticism” (article 348 of the Spanish civil law).

Construction of claims and interpretation of prior art

5 *How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art ?*

The claims are construed and interpreted from the viewpoint of the person skilled in the art.

6 *Is it possible to read embodiments from the body of the specification into the claims ?*

Article 60.1 of the Patent Law states that the scope of protection conferred by a patent or patent application shall be determined by the content of the claims. The description and drawings shall, however, be used to interpret the claims. This is consistent with Article 26 of the Patent Law stating that claims shall define the object for which protection is sought, they shall be clear and concise and shall be based on the description. Article 60 of the Patent Law was interpreted by the Memorandum accompanying the Draft Bill, defining an interpretation of the claims beyond its mere literality, supporting an interpretation within the context of the description and the drawings, but pointing out that to interpret does not mean to bring elements not claimed, not even implicitly, although they were described, since the claims and not the description delimit the invention protected by the patent.

Concerning claim construction, the system stated by the Patent Law coincides substantially with the regulation contained in the EPC. Although the Protocol for the interpretation of article 69 of the EPC is binding in Spain only in relation to European patents which have effects in that country, in practice it extends the scope of its influence to Spanish patents.

7 *How is the prior art interpreted ? Is it read literally or interpreted as would be understood by a person skilled in the art ? Is Reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted ?*

The prior art is interpreted from the viewpoint of a person skilled in the art, considering also the common general knowledge available at the filing date, or the priority date, of the application, as the case may be. Implicit disclosures may be permitted, in fact they have been taken into account in a Judgment of the Appeal Court of Barcelona¹ which identifies them as the logical process from which the presence of the implicit is extracted from the reading of what is explicit in the description, that is, the inevitability is derived from the deduction.

8 *Do the answers to any of the questions above differ during examination versus during litigation ?*

There may be differences in practice in the application of the legal criteria as a consequence of the factors mentioned in question 4.

Combination or modification of prior art

9 *Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference? If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered ?*

In accordance with the SPTO Guidelines, in certain cases the content of a single prior art reference can be sufficient for finding lack of inventive step.

For establishing the existence of inventive step, several technical features found in the same reference document can be combined, as in a given book, but only in the case in which this combination would have been obvious to a person skilled in the art, that is, if there would have been a reasonable possibility that a person skilled in the art would have been able to make the relation between the portions sections of the document.

¹ Appeal court of Barcelona, Section 15, Decision N° 116/2007, October 18th 2007.

The following are some examples of situations in which a single prior art reference comprises sufficient grounds to determine lack of inventive step:

- a. When a known technical feature in a technical field is applied to another field and this application would have been obvious to a person skilled in the art.
- b. When the difference between the content of the document and the subject claimed were already sufficiently known to render documentary evidence unnecessary.
- c. When the subject claimed deals with the use of a known product and said use would have been obvious in light of the known properties of the product.
- d. When the invention claimed differs from the known art simply due to the use of equivalent alternatives that may be sufficiently well known to render documentary evidence unnecessary.

Besides the specialized knowledge proper of a person skilled in the art, a technical feature that is already common general knowledge may also form part of the prior art. Thus the level of common general knowledge is also an important aspect to be taken into account.

10 What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required ?

The SPTO Guidelines indicate that to establish the existence of inventive step it is permissible to combine the content of two or more prior art references, but only in cases in which such a combination would have been obvious to a person skilled in the art.

To determine whether combining two or more separate references would have been obvious, the Spanish Patent and Trademark Office Examiner considers the following:

- a. Whether the nature and content of the references make such a combination likely or unlikely to a person skilled in the art.
- b. Whether the references pertain to similar or closely related technical fields and if not, whether they are sufficiently related to the specific problem addressed by the invention.

It would have also been obvious to a person skilled in the art to combine the content of the two references when one of them refers to the other in a clear and unquestionable manner.

Combining, replacing or modifying the content of one or more elements of the prior art can only lead to lack of inventive step if it would be reasonable to assume that the prior art or general knowledge proper of a person skilled in the art would have motivated him to effect said combination, replacement or modification with a reasonable expectation of successfully attaining the claimed invention. It is necessary, however, that there be a basis within the prior art that would suggest the combination.

11 When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed ? How relevant is the problem the inventor of the Claim in question was trying to solve ?

To evaluate the inventive step of a claim with respect to the combination of two or more prior art documents it is important to note the proximity of the technical field of such documents with respect to the technical field of the claimed invention, so that the expert in the field could not look at remote technical fields.

However, the problem to be resolved by the invention may drive a person skilled in the art to find its solution in another technical field.

To evaluate the inventive step concerning the combination of two or more prior art documents it is also important that these documents have a sufficient connection with the particular problem addressed by the invention.

12 Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness ? Is the standard different from when only two references are combined ?

The SPTO Guidelines indicate that to determine the existence of inventive activity is permissible to combine the contents of two or more documents relevant prior art.

In these Guidelines there is no indication similar to that in the Guidelines of the EPO (see Part C-IV, 11.6) on the fact that more than one disclosure must be combined with the closest prior art in order to arrive at a combination of features may be a sign of the presence of an inventive step.

As mentioned above, SPTO Guidelines are inspired substantially in those of the EPO and there is no signal leading to the conclusion that the SPTO is contrary to consider that the need to combine two or more references is not a sign of the presence of inventive step.

13 Do the answers to any of the questions above differ during examination versus during litigation ?

There may be differences in the practical application of legal standards due to the factors set forth in question 4.

Technical Problem

14 What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness ?

The technical problem plays an essential role in determining inventive step / non obviousness when the problem-solution approach criterion is applied.

The SPTO Guidelines establish that “one of the possible methods to assess inventive step” is the problem-solution approach (see Part E, point 6.6., pag 159), which corresponds to the problem solution approach of the EPO guidelines (see C-IV, 11-7). This criterion deems the technical problem as an essential point in determining inventive step. Then, it can be assumed that the SPTO will consider this point essential when using this approach.

The SPTO Guidelines also establish the so-called “problem inventions”, in which the inventive step lies in the recognition of a problem which was not obvious, being obvious the solution once the problem is proposed.

15 To what degree, if any, must the technical problem be disclosed or identified in the specification?

Art. 5.2 of the Spanish Patent Act 2245/1986 from October 10th, by which the implementing regulations were approved, formally requires that the Specification contains “an explanation of the invention as characterized in the claims that allow the understanding of the technical problem and the solution to the same”.

Notwithstanding this, the SPTO Guidelines do not mention the need to include the identification of the technical problem in the description in contrast with EPC, Rule 42 c) and EPO Guidelines, C-II, 4.5. However, from the OEPM Guidelines can be deduced that it is the Examiner’s task to determine the technical effect and, consequently, the underlying technical problem in the claimed invention. Therefore, the latter can be different to the problem proposed by the applicant.

This question is also reflected in the EPO Guidelines (C-VI, 11.5.2) that refer to the fact that the problem proposed by the applicant may not be the underlying subjective technical problem of the invention, which does not exclude that during granting proceedings the technical problem can be reconsidered.

Advantageous effects

16 What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

The SPTO Guidelines establish that “it must be avoided being influenced by the statements of the applicant contained in the description of various advantages of the invention, if such advantages are not derived directly from the difference with the state of the art in terms of technical features claimed” (Part E, point 6.6.1, pag 162).

The above does not exclude the fact that the inclusion of advantageous effects in the description could contribute decisively to perceive the existence of inventive step. In this sense, the EPO Guidelines indicate that such advantageous effects “are often important in determining inventive step” (C-IV, 1.3).

17 Must the advantageous effects be disclosed in the as-filed specification?

The SPTO Guidelines establish that “any advantage of the invention should explain, if necessary, in light of the solutions provided so far in the state of the art” (see Part D, point 5.5, Page 117). The EPO Guidelines, meanwhile, establish that the European Patent Convention does not require explicitly or implicitly that an invention, to be patentable, must entail some technical progress or even any useful effect”. Evidence of this is that inventions that are simply alternatives to other existing inventions may be patentable before the EPO and also before the OEPM.

18 Is it possible to have later-submitted data considered by the Examiner ?

It is possible that the Examiner takes into account data submitted later by the applicant as far as these data are useful, for example, to justify the existence of inventive step,

whether in the event that the problem has not been reformulated or in the event that it has been reformulated.

The SPTO Guidelines contain no specific reference to this possibility, unlike what happens with the EPO Guidelines (Part C-IV, 5.3.5 and 11.11), when they state that the arguments to be taken into consideration by the Examiner to determine the existence of inventive step can be obtained from the patent application as filed, or provided latter by the applicant during prosecution.

19 How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient ?

SPTO Guidelines do not clarify this question. It is stated in said Guidelines that "it must be avoided being influenced by the statements of the applicant contained in the description of various advantages of the invention, if such advantages are not derived directly from the difference with the state of the art in terms of technical features claimed" (Part E, point 6.6.1, page 162).

20 Do the answers to any of the questions above differ during examination versus during litigation?

There may be differences in the practical application of legal standards due to the factors set forth in answering question 4.

Teaching away

21 Does your jurisdiction recognize teaching away as a factor in favor of inventive step / non-obviousness? Must the teaching be explicit?

The Patent Law neither foresees nor expressly recognises the mentioned factor.

In spite of that, said factor seems indeed to be mentioned in the SPTO Guidelines when, in the examples, in order to illustrate aspects concerning the inventive step (please, see Part E, chapter 6.5.g, page 172) mentions that of "overcoming a technical prejudice". In particular, said Guidelines state that: *"In general, there is inventive step if the state of the art leads a skilled person away from the method proposed by the claimed invention. This is applied, in particular, when a skilled person could not even think of carrying out the experiments in order to determine whether they are alternatives to the means known for overcoming a technical problem, either real or imagined"*. In this way, the EPO Guidelines would be followed.

This concept has been used in some lawsuits in order to defend the concurrence of the inventive step. As an example thereof, as it results from the Decision of the Appeal Court of Barcelona², in which the Court has indicated that it is a reasonable argument to be considered, although the Court actually rejected it, and to support the lack of inventive step of the analyzed patent based on different considerations.

22 Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

Taking into account the above chapter, it is still too early to give an opinion about the level of importance of the mentioned factor, but doubtless the more it is argued in legal

² Appeal court of Barcelona, Section 15, Decision Nº 91/2008, June 2nd 2010.

proceedings, more chances there will be that the Courts finally analyze it and justify the origin and importance thereof.

In any case, it is another factor to be considered as an indicator of concurrence of inventive step, and the importance thereof shall depend on each case, in particular on the impact of the technical or scientific prejudice to be overcome. In particular, bearing in mind that it seems to be foreseen both in the SPTO Guidelines, and in the EPO Guidelines.

23 Is there any difference in how teaching away is applied during examination versus in litigation?

Taking into account that a very small percentage of the total amount of applications (about 8%) actually chooses the optional granting procedure with substantive examination for Spanish patent applications, currently we do not have enough information relevant information regarding the application of this factor during the above mentioned examination.

Nevertheless, there can be differences in the practical application of the legal criteria as a consequence of the factors indicated in the response of question 4.

Secondary considerations

24 Are secondary considerations recognized in your jurisdiction?

As in the case of “*teaching away*”, the Patent Law does not foresee any provisions dealing with “secondary considerations”. On the contrary, the SPTO Guidelines, as the EPO Guidelines, actually deal with “secondary considerations” or with “considerations related to inventive step”. In turn, the Courts have indeed developed different aspects, factors or evidences which can be used as indicators of inventive step.

25 If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

Even in case that the SPTO has its own Guidelines for Examination and they do not completely coincide with those of the EPO, in what we are dealing with, they are quite homogeneous therewith.

The EPO Guidelines refer to “*secondary indicators*” and the Guidelines for Examination of the SPTO refer to “*indicators related to inventive step*”, citing two categories of indicators: “*the technical value, the needs experienced since a long time ago*” and “*the commercial success*”.

In this sense, the SPTO Guidelines cite as indicators supporting the existence of inventive step, the following (Page 158):

- if the claimed invention fulfils a need experienced since a long time ago;
- if the claimed invention overcomes a technical prejudice;
- if there have been previous attempts, which have not successfully ended, to achieve the result reached by the claimed invention;
- if the claimed invention leads to an unexpected result; and
- if the claimed invention has obtained a remarkable commercial success.

26 Do the answers to any of the questions above differ during examination versus during litigation?

The Spanish Courts considered useful and illustrative the EPO criteria, established in the Guidelines for Examinations and in the doctrine emanated from the Board of Appeal, given that it is considered that they provide interpretation guidelines about key concepts of the EPC, which must be taken into account and which are also useful for Spanish patents due to the fact that both legal systems are inspired in the same principles.

Based on the above, the Courts have established that it may be useful for supporting the inventive step the fact that the examined invention provides improvements with respect to the closest state of the art, and even the possible commercial success of the invention, either exemplified by the reaction of the competitors, by the grant of licenses to third parties, or in any other way.

As a result, the differences with respect to litigations are not remarkable, being very likely that the SPTO and the Courts follow the same criterion in this sense.

Other considerations

27 In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

No, to date neither the SPTO Guidelines, nor the case law of the Spanish Courts have established other general factors to be taken into account in this respect.

If yes, please describe these issues, tests, factors.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and, if so, provide a brief summary of such interpretation.

Art. 8.1 of the Patent Law defines that “*an invention involves inventive activity if it does not result obvious from the state of the art for the skilled person*”. The law does not set a specific test for the obviousness criteria. However, the SPTO Guidelines, at pages 151-159 specifies some guidance on the inventive step tests applied by the SPTO:

- There is a definition of obviousness: something is obvious if it does not go beyond the normal progress of technology, something that can be deduced simply or logically from the prior art, which does not involve any ability or quality beyond what is expected of the skilled person.
- The claimed invention has to be considered as a whole, with all technical features in combination.
- The prior art has to be considered as a whole, and it is possible to combine two or more pieces of prior art.
- There must be a motivation in the state of the art, the invention is obvious if one piece of prior art induces the skilled person to modify, combine or substitute the elements of

one or more pieces of prior art to arrive at the claimed invention. The could/would approach is explicitly mentioned at page 165 of the Guidelines.

- Hindsight (ex post facto analysis) should be avoided.

In addition, the SPTO Guidelines make explicit reference to the Problem – solution approach as “*one of the possible tests for assessing inventive step*” (see page 159), based on 5 questions:

1. What is the closest state of the art?
2. What is the difference, in terms of technical features, between the claimed invention and the closest state of the art?
3. What technical effect derives from such a difference?
4. What is, in consequence, the objective technical problem underlying the claimed invention?
5. Would the skilled person, in view of the whole technical teaching of the state of the art, and without using any inventive skill,
 - a. Have recognized the problem, and
 - b. Would have solved the problem in the given way?

This test is very much derived from the established test developed by EPO Case Law and explained in the EPO Guidelines.

29. Does such test differ during examination versus during litigation?

There might be some differences in the application of the legal requirements as a result of the circumstances mentioned in the answer to question 4.

Patent granting authorities versus courts

30 If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

No additional areas have been detected that deserve to be specified here, although case law may entail few isolated rulings (which precisely for being specific could they hardly be considered as general).

31 Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

Generally speaking, the answer is in the negative. In their approach to inventive step, Spanish Courts tend to follow EPO guidelines, which have essentially been assumed by the SPTO. Consequently, divergences between Spanish Courts and the patent granting authorities do not frequently take place.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

No. Spain is under two different patent granting authorities: the SPTO which grants national patents with or without substantive examination, and the EPO, which grants European patents designating Spain, with examination.

The approach followed by the SPTO and the EPO is in principle the same, since both use the same problem-solution approach and very similar considerations regarding obviousness of the invention, as discussed in question 28.

33. If yes, is this problematic?

Not applicable. If there were any difference in the evaluation of the inventive step in a given case and, in particular, if the patent at hand was the Spanish part of a European patent, we assume that the Spanish Courts will tend to follow the approach or criteria followed by the EPO, since in several decisions they have explicitly recommended EPO case Law and EPO Guidelines, with the aim to follow an harmonized approach in Europe.

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonized rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. *Is harmonization of inventive step / non obviousness desirable ?*

The harmonization of inventive step / non-obviousness is desirable for granting patents with a similar scope of protection in different jurisdictions.

35. *Is it possible to find a standard for inventive step/ non obviousness that would be universally acceptable ?*

There is the possibility of finding a standard for inventive step / non obviousness. In the majority of patent laws, inventive step is evaluated starting from the state of the art at the date of filing the application or at the priority date. Inventive step is analyzed from the perspective of a person skilled in the art. As a consequence it would be desirable to harmonize the definitions of prior art and person skilled in the art.

36. *Please propose a definition for inventive step/ non obviousness that you would consider to be broadly acceptable ?*

An invention involves inventive step if, for a person skilled in the art, it is not obvious in view of the state of the art.

Beyond the definition of inventive step, it would be desirable to have a definition of prior art on the one hand, and skilled in the art on the other hand, both universally acceptable.

37. *Please propose an approach to the application of this definition that Could be used by examiners and by courts in determining inventive step / non obviousness.*

The approach used by both the SPTO and by the EPO maintains objectivity when assessing inventive step / non obviousness. To achieve this objective, prior to the self-assessment of inventive step / non-obviousness, one has to define / identify a technical problem, or alternatively a technical objective that the object of the invention can solve or achieve. The solution to the problem or the means that will achieve the objective

should provide advantages over existing technology. The solution or the advantages should not be obvious to a person skilled in the art knowing the state of the art at the date of filing or at the priority date of the patent application. The person skilled in the art should perform the evaluation of inventive step, strictly starting from the teaching available in the state of the art, avoiding taking into account the knowledge resulting from the lecture of the description of the material under examination.

SUMMARY

Under Spanish Patent Law, inventive step/non obviousness is evaluated from the perspective of the person skilled in the art taking into account state of the art on the filing date of the patent application, or on the priority date. In general, regulation of inventive step in the Spanish Patent Law follows the rules of the European Patent Convention.

For the purposes of examination of this requirement by the Spanish Patent and Trademark Office (SPTO) guidelines have been developed, some of its chapters dealing specifically with the criteria that can be taken into consideration to evaluate the presence or not of inventive step, and are substantially equivalent to the criteria contained in the Guidelines for examination in the European Patent Office.

The guidelines of SPTO, despite having no legal binding character, are an extremely useful tool, and the mentioned criteria, applied by SPTO examiners to prosecute patent applications, are often taken into consideration by courts when judging the validity of granted patents under dispute. So the standard of inventive step/ non obviousness during examination versus during litigation does not differ significantly.

Guidelines do consider the combination of different elements of the state of the art to evaluate inventive step/non obviousness, nevertheless, in some cases the contents of a single document can be determinant for the lack of inventive step. The technical problem to be solved, which may not be the one thought by the applicant, plays an essential role in determining inventive step/non obviousness when the problem-solution approach is used, being advantageous effects, teaching away, and side effects factors to be considered as secondary considerations of the concurrence of inventive step / non obviousness.

RÉSUMÉ

Selon la législation Espagnole, le critère d'activité inventive / non évidence des brevets est évalué du point de vue de l'homme du métier, prenant en compte l'état de la technique disponible à la date de dépôt de la demande de brevet ou la date de priorité. De manière générale, l'appréciation de l'activité inventive selon la loi espagnole sur les brevets d'invention suit les règles de la Convention sur le brevet européen.

Dans le cadre de l'examen de ce critère par l'Office Espagnol des Brevets et des Marques (OEPM), des directrices d'examen ont été élaborées, et plusieurs chapitres sont dédiés spécifiquement aux critères à considérer pour évaluer l'existence ou non d'une activité inventive pour les demandes de brevet. En substance, elles coïncident avec les critères présents dans les Directives relatives à l'examen pratiqué à l'Office européen des Brevets.

Ces directrices, bien que n'ayant pas un caractère normatif, constituent un outil d'une grande utilité, et les critères mentionnés, appliqués par les examinateurs de l'OEPM pour juger les demandes de brevets, sont pris en considération par les tribunaux au moment de juger la validité des Brevets délivrés mis en cause. Ainsi le standard d'activité inventive / non

évidence appliqué pendant la phase d'examen ne diffère pas significativement de celui appliqué dans le cadre d'un litige.

Les directrices mentionnées précédemment prennent en compte la combinaison d'éléments distincts présents dans l'état de la technique pour évaluer l'activité inventive / non évidence, et notamment établissent, dans certains cas, que le contenu d'un seul document peut être déterminant au moment de démontrer le manque d'activité inventive ; le problème technique à résoudre, qui peut être différent de celui mentionné par le demandeur, joue un rôle essentiel dans la détermination de l'activité inventive / non évidence, à la condition expresse d'utiliser l'approche problème-solution, auquel cas les avantages, les enseignements qui éloignent l'homme du métier de la solution proposée, ainsi que les effets secondaires sont autant de critères à prendre en compte en tant qu'indices en faveur de la présence d'activité inventive / non évidence.

RESUMEN

Según la legislación española, el requisito de la actividad inventiva/no obviedad de las Patentes se aprecia desde la perspectiva del experto en la materia y toma en consideración el estado de la técnica en la fecha de solicitud o prioridad de la Patente. En términos generales, la regulación de la actividad inventiva en la Ley española de Patentes sigue las pautas del Convenio sobre concesión de Patentes Europeas.

A los efectos del examen de este requisito por parte de la Oficina Española de Patentes y Marcas (OEPM), se han elaborado unas Directrices de examen, algunos de cuyos capítulos se dedican específicamente a los criterios que pueden tomarse en consideración para valorar la existencia o no de actividad inventiva de las solicitudes de Patentes, y coinciden sustancialmente con los criterios expresados en las Directrices de la Oficina Europea de Patentes (EPO).

Estas Directrices, pese a no tener carácter normativo, constituyen una herramienta de enorme utilidad, y sus criterios, aplicados por los Examinadores de la OEPM para enjuiciar las solicitudes de Patente, son frecuentemente tomados en consideración por los Tribunales en el momento de enjuiciar la validez de las Patentes concedidas que se cuestionan, por lo que el estándar de la actividad inventiva / no obviedad durante el examen y en el marco de un litigio no difiere significativamente.

Las mencionadas Directrices parten de la combinación de distintos elementos del estado de la técnica para valorar la actividad inventiva / no obviedad, si bien establecen que, en ciertos casos, el contenido de un solo documento puede ser determinante de dicha falta de actividad inventiva; el problema técnico a resolver, que puede no ser el problema técnico planteado por el solicitante, desempeña un papel esencial en la determinación de la actividad inventiva / no obviedad, siempre que se utiliza el método problema-solución, siendo los efectos ventajosos, las enseñanzas que alejan al experto en la materia de la solución propuesta y los efectos secundarios criterios a tener en cuenta a modo de indicios de la concurrencia de actividad inventiva / no obviedad.